

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :David BROWN et al. **Confirmation No. 4047**
Appl. No. :10/736,902 Group Art Unit: 1618
Filed :December 17, 2003 Examiner: Sheikh, Humera N.
For :DOSAGE FORM CONTAINING PROMETHAZINE AND ANOTHER
 DRUG

RESPONSE TO OFFICE COMMUNICATION MAILED 07/11/2008

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is in response to the Office communication mailed from the U.S. Patent and Trademark Office on July 11, 2008. Inasmuch as the one month period for reply is set in the Office communication to expire August 11, 2008, this response is being filed by the initial due date for response. However, if any extension of time is necessary, this is an express request for any necessary extension of time and authorization to charge any required extension of time fee or any other fees which may be required to preserve the pendency of the present application to Deposit Account No. 19-0089.

REMARKS

Appellants note that the Examiner takes the position that “[t]he reply filed on April 25, 2008 [= Appeal Brief] is not fully responsive to the prior Office Action ... as it does not address the non-elected claims (25, 26 & 39-67)”. In this regard, the Examiner relies on MPEP 821.01 and alleges that “[a] complete response to the Final Office Action must either cancel or petition the non-elected claims that were withdrawn with traverse”.

Appellants respectfully submit that the Examiner appears to have misconstrued MPEP 821.01. While MPEP 821.01 is admittedly not very easy to understand, it is apparent that MPEP 821.01 does not require the cancellation of non-elected claims in response to a Final Office Action. Specifically, MPEP 821.01 states, *inter alia* (emphasis added):

Where a reply to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the nonelected *>invention(s) not eligible for rejoinder< or to take appropriate action will be construed as authorization to cancel these claims by examiner's amendment and pass the application to issue after the expiration of the period for reply.

Note that the petition under 37 CFR 1.144 must be filed not later than appeal. This is construed to mean appeal to the Board of Patent Appeals and Interferences. If the application is ready for allowance after appeal and no petition has been filed, the examiner should simply cancel * nonelected claims >that are not eligible for rejoinder< by examiner's amendment, calling attention to the provisions of 37 CFR 1.144.

In other words, if an applicant were indeed required to cancel non-elected claims in response to a Final Office Action the above passage from MPEP 821.01 would be superfluous because it would not be possible for non-elected claims to be present after a

(complete) reply to a Final Office Action or after appeal. Also, it is not even clear whether an appeal brief qualifies as a "Response to a Final Office Action".

At any rate, canceling non-elected claims before or concurrently with the filing of an appeal would not make sense already for the reason that in the case of a successful appeal non-elected claims which would be eligible for rejoinder would no longer be present and would have to be added again.

It appears that MPEP 821.01 only indicates that once an appeal has been filed, a petition under 37 CFR 1.144 can no longer be filed, i.e., an applicant who has elected claims with traverse in response to a Requirement for Restriction can no longer petition the Requirement after the filing of an appeal.

Appellants respectfully submit that for at least all of the foregoing reasons, Appellants are not required to take any action with respect to the non-elected claims.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number below.

Respectfully submitted,
David BROWN et al.



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August 11, 2008
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